

REMARKS

Applicants thank the Examiner for the very thorough consideration given the present application.

Claims 1-12, 14-24 and 26-28 are now present in this application. Claim 1 is independent.

Claims 1, 8 and 17 have been amended. Claims 26-28 have been added. No new matter is involved. Reconsideration of this application, as amended, is respectfully requested.

Claim Amendments

Applicants have amended independent claims 1, 8 and 17 to indicate that the amorphous transparent conductive films are of a sufficient thickness to prevent generation of a galvanic effect. Support for this feature is found throughout Applicants' original disclosure including, for example, in paragraphs 49 and 58-62, and original claim 24. Claims 26-28, which recite, among other features, polycrystalline transparent conductive film(s) of sufficient thickness to prevent generation of a galvanic effect by a stripper, are clearly supported in Applicants' original disclosure, for example, in paragraph [0062], recite a feature clearly not shown in any of the applied art.

Rejections under 35 U.S.C. §103

Claims 1, 8 and 17 stand rejected under 35 U.S.C. §103(a) as being

unpatentable over "Applicant admitted prior art (AAPA)" in view of U.S. Patent 6,433,842 to Kaneko et al. (hereinafter, "Kaneko") in view of U.S. Patent 6,310,674 to Suzuki et al.. (hereinafter, "Suzuki"). This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

In the first place, Applicants have not admitted that Figures 1-2 and paragraphs [0005] – [0026] are prior art to Applicants. In Fleming v. Giesa (BdPatApp&Int) 13 USPQ2d 1052 (7/17/1989) it was held that that for an admission to be used against a party, it must be clear, unequivocal and unmistakable. See also, Harner et al. v. Barron et al., 215 USPQ 743 (Comr Pats 1981), Suh v. Hoefle (BdPatApp&Int) 23 USPQ2d 1321 (4/30/1991), Issidorides v. Ley (BdPatApp&Int) 4 USPQ2d 1854 (4/2/1985) and Ex parte The Successor In Interest Of Robert S. McGaughey (BdPatApp&Int) 6 USPQ2d 1334 (3/4/1988).

All that Applicants have done is to refer to Figs. 1-2 as "Related Art." Something can be related art in the sense that it is practiced in the real world at the time of Applicants' filing of this Application and may yet not be prior art to Applicants in any sense, including, for example, under 35 USC §103, which forms the basis for this rejection. See, in this regard, the relatively recent amendments to 35 USC 103(c).

Under the circumstances, i.e., where Applicants merely describe Figs. 1-2 as related art, the Office Action has not established that Applicants have made a clear, unequivocal and unmistakable admission on the record that what is disclosed in Figs. 1-2 is prior art to Applicants. In this regard, the Examiner is also advised that the initial burden to establish something as prior art is on the Office as part of its burden of making out a *prima facie* case of unpatentability. During patent examination the PTO bears the initial burden of presenting a *prima facie* case of unpatentability. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444(Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788(Fed. Cir. 1984). If the PTO fails to meet this burden, then Applicants are entitled to the patent. Only when a *prima facie* case is made, the burden shifts to the Applicants to come forward to rebut such a case.

Applicants respectfully submit that the Office has not made out a *prima facie* case of unpatentability at least because it has not made out a *prima facie* case that Figs. 1-2 are prior art to Applicants.

In the second place, the Office Action fails to provide any objective evidence of proper motivation to modify Figs. 1-2, which have not been established to be prior art to Applicants, in view of the secondary reference to Kaneko and the tertiary reference to Suzuki.

In rejecting claims under 35 USC 103, it is incumbent on the Examiner to establish a factual basis to support the legal conclusion of obviousness. See, In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one of ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. F-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a *prima facie* case of obviousness. Note, In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The mere fact that the prior art may be modified in the manner suggested by the examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992).

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be suggested or taught by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1970). All words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

A suggestion, teaching, or motivation to combine the prior art references is an "essential evidentiary component of an obviousness holding." C.R. Bard, Inc. v. M3 Sys. Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not "evidence." See In re Dembiczak, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed. Cir. 1999).

The alleged reason that one of ordinary skill in the art would have to desire to modify Figs. 1-3 in view of Kaneko and Suzuki is stated on page 4, lines 5-10 of the Office Action. The language is not easy to follow, but it appears that the Examiner is indicating that because both Kaneko and Suzuki disclose using an amorphous ITO pixel electrode to prevent generation of a galvanic effect, it would be obvious to modify Applicants' Figs. 1 and 2 to form the pixel electrode and prevent contact failure of the drain electrode, etc. Applicants respectfully submit that this reason begs the question and is improperly relying on Applicants' own disclosure that there is a problem with

Figs. 1 and 2. This is improper hindsight reconstruction of Applicants' invention.

Moreover, in making a rejection under 35 USC §103, the prior art as a whole must be considered. The teachings of the applied references are to be viewed as they would have been viewed by one of ordinary skill in the art. Kimberly-Clark v. Johnson & Johnson, 745 F.2d 1437, 1454, 223 USPQ 603, 614 (Fed. Cir. 1984); In re Mercier, 515 F.2d 1161, 1165, 185 USPQ 774, 778 (CCPA 1975). "It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art". In re Wesslau, 353 F.2d at 241, 147, USPQ at 393. In re Hedges, et al., 228 USPQ 685 (Fed. Cir. 1986).

In this instance, the Office Action has not established any prior art for Kaneko and Suzuki to modify.

Moreover, Figs. 1-2, which have not been established as prior art to Applicants under 35 USC 103(c), do not indicate any problems such as a need for preventing generation of a galvanic effect caused by a stripper. Only Applicants' disclosure discloses that Figs. 1 and 2 have such a problem that needs to be solved.

This rejection is treating Applicants' disclosure as prior art with no proper basis on which to do so. In making its determination the prior art must be viewed without reading into that art the patent's teachings. In re Sponnoble, 405 F.2d 578, 585, 160 USPQ 237, 243 (CCPA 1969). Moreover, "discovery of the source of a problem" is part of the "subject matter as a whole" to be considered in determining obviousness – see Sponnoble, cited above

As a result, this rejection is a prime example of improper hindsight reconstruction of Applicants' invention based on Applicants' own disclosure of his invention, and that is fundamentally improper.

Accordingly, this rejection of claims 1, 8 and 17 is improper and should be withdrawn.

The Office Action rejects claims 2-5, 9-12 and 18-22 under 35 USC §103(a) as unpatentable over "Applicant admitted prior art" in view of Kaneko and Suzuki, as applied above, and further in view of U.S. Patent No. 5,135,581 to Tran et al. (hereinafter, "Tran"). This rejection is respectfully traversed.

This rejection is improper at least for the reasons that the rejection of claims 1, 8 and 17, from which claims 2-5, 9-12 and 18-22 respectively depend, are improper, as discussed above. The alleged motivation to modify the improper base reference combination in view of Tran is given as "reducing visible light absorption and achieving more stable characteristics." Unfortunately, the Office Action fails to provide objective evidence in the prior

art of a need, or the knowledge of a need to “have reduced visible light absorption or more stable characteristics” in the claimed invention.

Thus, this reason is based completely on improper hindsight reconstruction of the claimed invention based solely on Applicant’s disclosure.

Moreover, “reducing visible light absorption and achieving more stable characteristics” is nothing more than a broad a broad conclusory statement about the teaching of multiple references, and, standing alone, is not “evidence” of proper motivation to the base reference combination (which itself is improper). See In re Dembiczak, cited above.

Accordingly, Applicants respectfully submit that this rejection of claims 2-5, 9-12 and 18-22 is improper and should be withdrawn.

The Office Action rejects claims 6-7, 14-16 and 23-24 under 35 USC §103(a) as unpatentable over “Applicant admitted prior art” in view of Kaneko and Suzuki, as applied above, and further in view of U.S. Published Patent Application No. 2001/0029054 to Maeda et al. (hereinafter, “Maeda”). This rejection is respectfully traversed.

This rejection is improper at least for the reasons that the rejection of claims 1, 8 and 17, from which claims 6-7, 14-16 and 23-24 respectively depend, are improper, as discussed above. The alleged motivation to modify the improper base reference combination in view of Maeda to that Maeda

teaches film thicknesses of amorphous transparent ITO pixel electrodes of from 50 to 200 nm (from 500 to 2000 Angstroms).

However, that thickness is taught to prevent coloring - see paragraph [0100], a problem not shown to exist in the base reference combination to which Maeda is applied in this rejection.

Accordingly, this rejection is based on improper hindsight reconstruction of Applicants' invention based solely in Applicants' disclosure.

Thus, reconsideration and withdrawal of this rejection of claims 6-7, 14-16 and 23-24 are respectfully requested.

New Claims 26-28

Claims 26, 27 and 28 correspond to claims 1, 8 and 17, respectively with the exception that, instead of reciting a pixel electrode or conductive film (or forming a pixel electrode or conductive film) made of an amorphous transparent conductive film for preventing a generation of a galvanic effect by a stripper, claims 26, 27 and 28 recite a pixel electrode or conductive film (or a method of making a pixel electrode or conductive film) made of a polycrystalline transparent conductive film of sufficient thickness to prevent generation of a galvanic effect by a stripper. None of the applied references disclose such features.

Additional Cited References

Since the remaining references cited by the Examiner have not been utilized to reject the claims, but have merely been cited to show the state of the art, no comment need be made with respect thereto.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

Request for Interview

Applicants request a telephone interview prior to treatment of this Office Action on its merits. Applicants intend to file a separate request for interview within about a month, as requested by Examiner Qi during a discussion on June 28, 2004. In any event, if the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Robert J. Webster, Registration No. 46,472, at (703) 205-8000, in the Washington, D.C. area.

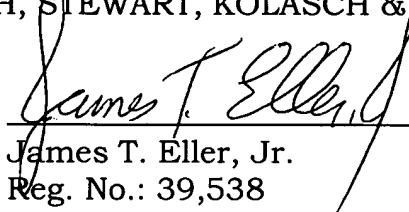
Prompt and favorable consideration of this Amendment is respectfully requested.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By:


James T. Eller, Jr.
Reg. No.: 39,538

JTE/RJW/adt 

P.O. Box 747
Falls Church, Virginia 22040-0747
Telephone: (703) 205-8000